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Paper 9
August 29, 2019

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE PATENT TRIAL AND APPEAL BOARD

APPLE INC.,
Petitioner,

v.

RED.COM, LLC,
Patent Owner.

Case IPR2019-01064 (Patent 9,230,299 B2)
Case IPR2019-01065 (Patent 9,245,314 B2)

Before J. JOHN LEE and JASON M. REPKO, *Administrative Patent Judges*.

REPKO, *Administrative Patent Judge*.

ORDER
Conduct of the Proceeding
Granting Patent Owner's Motion to Seal
37 C.F.R. §§ 42.5 and 42.54(a)

AUTHORIZING PETITIONER'S MOTION

A conference call was held on August 27, 2019 between counsel for both parties and Judges Lee and Repko to discuss (1) Petitioner's request for authorization to file a five-page reply to Patent Owner's Preliminary Response and (2) Petitioner's request for authorization to file a motion for pre-institution discovery in both IPR2019-01064 and IPR2019-01065. *See* Ex. 3001 (email dated Aug. 26, 2019). With these requests, Petitioner seeks to address Patent Owner's argument and evidence about actual reduction to practice. *See id.*

Patent Owner opposes Petitioner's request for pre-institution discovery. Patent Owner does not oppose Petitioner's motion to file a reply if Patent Owner is given a sur-reply of the same length.

In the call, we authorized Petitioner to file the motion requesting pre-institution discovery. At this time, we hold in abeyance Petitioner's request for a reply (and Patent Owner's corresponding request for s sur-reply) until we issue a decision on Petitioner's discovery motion. The motion must not exceed five pages and must be filed no later than September 4, 2019.

Petitioner's motion must explain why the additional discovery "is necessary in the interest of justice." *See* 35 U.S.C. § 316(a)(5). For instance, to determine whether to allow additional discovery, the Board applies several factors on a case-by-case basis. *See Garmin Int'l, Inc. v. Cuozzo Speed Techs. LLC*, Case IPR2012-00001, slip op. at 6–7 (PTAB Mar. 5, 2013) (Paper 26) (precedential) (listing the factors). In this case, we emphasize that (1) "[t]he party requesting discovery should already be in possession of evidence tending to show beyond speculation that in fact something useful will be uncovered" and (2) the request should be

"responsibly tailored according to a genuine need." *Id*. Also, Petitioner's motion must not exceed the items that were discussed in the call: (1) depositions of Mr. Jannard, Mr. Nattress, and Mr. Land; (2) documentation in Patent Owner's possession dated before April 13, 2007 sufficient to show that the "Mysterium CMOS image sensor" practices the relevant claims of the challenged patents; (3) data files in Patent Owner's possession generated by either the "Boris" or "Natasha" cameras before April 13, 2007; and (4) the "Boris" and "Natasha" cameras for inspection by Petitioner's expert. *See* Ex. 3001.

We also authorized Patent Owner to file an opposition to Petitioner's motion, which must be filed no later than September 11, 2019. The opposition also must not exceed five pages.

GRANTING PATENT OWNER'S MOTION TO SEAL

In both IPR2019-01064 and IPR2019-01065, Patent Owner moves to seal the unredacted version of Exhibit 2010. IPR2019-01064, Paper 8, 1.[1] Petitioner does not oppose. Patent Owner proposes using the Board's model Default Protective Order in the July 2019 Office Patent Trial Practice Guide Update as the protective order governing the parties in this case. *Id.* Petitioner does not object. *Id.*

We grant Patent Owner's motion.

There is a strong public policy that favors making information filed in *inter partes* review proceedings open to the public. *See Garmin*, slip op. at 3

[1] Patent Owner filed substantially identical motions in both proceedings. *See* IPR2019-01064, Paper 8; IPR2019-01065, Paper 7. For brevity, we refer to the pages of the motion in IPR2019-01064 (Paper 8).

(Paper 34) (discussing the standards of the Board applied to motions to seal). The moving party bears the burden of showing that the relief requested should be granted. 37 C.F.R. § 42.20(c). That includes showing that the information is confidential and that this confidentiality outweighs the strong public interest in having an open record. *See Garmin*, slip op. at 1–3 (Paper 34).

Patent Owner here asserts that good cause exists to seal Exhibit 2010[2] because "Exhibit 2010 is Patent Owner's business record containing confidential and proprietary technical and business information relating to Patent Owner's products," and its disclosure "would competitively harm Patent Owner by exposing Patent Owner's confidential and proprietary technology and business information to potential competitors." IPR2019-01064, Paper 8, 1–2. We have considered the arguments presented in the Motion to Seal and determine that there is good cause for sealing.

The parties are reminded that confidential information subject to a protective order ordinarily becomes public 45 days after final judgment in a trial. Office Patent Trial Practice Guide, 77 Fed. Reg. 48,756, 48,761 (Aug. 14, 2012). It is expected that information will be made public when the existence of the information is identified in a final written decision following a trial. *Id.* After final judgment in a trial, a party may file a motion to expunge confidential information from the record before the information becomes public. *See* 37 C.F.R. § 42.56.

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[2] In both proceedings, Patent Owner filed the same document, with and without redactions, and the document was given the same number.

ORDER

It is

ORDERED that Petitioner is authorized to file a motion for pre-institution discovery in each of the above-captioned cases, no later than September 4, 2019, as limited in the way discussed above;

FURTHER ORDERED that Patent Owner is authorized to file an opposition to Petitioner's motion in each case, which must be filed no later than September 11, 2019; and

FURTHER ORDERED that Patent Owner's Motion to Seal in each case is *granted*.

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